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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,826	02/27/2001	Ronald Peter W. Kesselmanns	294-96 PCT/U	8612

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EXAMINER

WHITE, EVERETT NMN

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 09/26/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/743,826

Applicant(s)

KESSELMANS ET AL.

Examiner

EVERETT WHITE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-21 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-20 and 32 is/are allowed.
- 6) ☒ Claim(s) 21 and 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 15, 2003 has been entered.
2. The amendment filed August 15, 2003 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
 - (A) Claims 15, 21, and 27-31 have been amended;
 - (B) Claims 22-26 have been canceled; Claims 1-14 were previously canceled;
 - (C) New Claim 32 has been added;
 - (D) Comments regarding Art Rejection have been provided drawn to
 - (a) 103(a) rejection of Claims 15-20, which has been withdrawn;
 - (b) 103(a) rejection of Claims 21 and 27-31, which has been maintained for the reasons of record.
3. Claims 15-21 and 27-32 are pending in the case.
4. The text of those sections of title 35, U. S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 21, 27 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Wikstrom (WO 97/04167, already of record).

Applicants claimed an oxidized starch products in the form of product-by-process claims. Applicants also claim a binder in paper coatings or surface sizing and a coating of glass fibers in warp yarn sizing – each product in the form of product-by-process claims, wherein each product consists essentially an oxidized starch.

The Office generally considers product-by-process claims as product claims. Applicants are reminded that process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), supra; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981.

The Wikstrom WO patent discloses an oxidized amylopectin starch (see Example 2 on page 4 of the Wikstrom WO patent), which anticipates the oxidized starch of Claim 21. See the sentence at lines 13-15 on page 2 of the Wikstrom WO patent, which discloses that the amylopectin content of amylopectin-type starch disclosed in the Wikstrom WO patent is in excess of 95%, preferable in excess of 98%. The Wikstrom WO patent further discloses the amylopectin-type starch as being use to produce a finishing agent, which further allows the manufacturing of surface-sizing and coating products (see page 2, lines 29-33). The surface-sizing and coating product of the Wikstrom WO patent anticipates the coating product set forth in instant Claims 27 and 30.

7. Applicant's arguments with respect to Claims 21, 27 and 30 have been considered but are moot in view of the new ground(s) of rejection.

8. Claims 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Huizenga (EP 799837, already of record).

Applicants claim an adhesive; a protective colloid for stabilizing emulsions; a coating of glass fibers in warp yarn sizing; and a food additive – in form of product-by-process claims, wherein each product consists essentially of an oxidized starch.

The Office generally considers product-by-process claims as product claims. Applicants are reminded that process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), *supra*; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981.

The Huizenga EP patent discloses compositions that comprise an amylopectin-potato starch that may be used in different products that include food products and adhesives (see page 4, lines 21 and 22), which embraces the adhesive of instant Claim 28 and the food additive of instant Claim 31. See page 3, lines 1 and 2 of the Huizenga EP patent wherein the amylopectin-potato starch is disclosed as having an amylopectin content of at least 95 wt.%, based on the dry substance. The amylopectin-potato starch of the Huizenga EP patent is disclosed as being effective as a dispersing agent with emulsifying agents, which is within the scope of the protective colloid for stabilizing emulsions claimed in instant Claim 29. See page 3, lines 49 and 50, wherein the amylopectin-potato starch products of the Huizenga EP patent may be obtained by partial depolymerization of amylopectin-potato starch under the influence of oxidants, which anticipates the instantly claimed oxidized starch products of the instant claims.

9. Applicant's arguments with respect to Claims 28-31 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

10. Claims 21, 27 and 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wikstrom (WO 97/04167) for reasons set forth in previously filed Office Actions.

11. Claims 28, 29 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Huizenga EP patent (EP 0799837) for reasons set forth in previously filed Office Actions.

Applicants claimed an oxidized starch products in the form of product-by-process claims. Applicants also claim a binder in paper coatings or surface sizing; an adhesive; a protective colloid for stabilizing emulsions; a coating of glass fibers in warp yarn sizing; and a food additive – all claimed products in the form of product-by-process claims, and each product consisting essentially of an oxidized starch. The Office generally considers product-by-process claims as product claims. Applicants are reminded that process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art. *In re Thorpe et al.* (CAFC 1985), supra; *In re Dike* (CCPA 1968) 394 F2d 584, 157 USPQ 581; *Tri-Wall Containers, Inc. v. United States et al.* (Ct Cls 1969) 408 F2d 748, 161 USPQ 116; *In re Brown et al.* (CCPA 1972) 450 F2d 531, 173 USPQ 685; *Ex parte Edwards et al.* (BPAI 1986) 231 USPQ 981.

12. Applicant's arguments filed August 27, 2003 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that the two-step claimed process is not disclosed or suggested by Wikstrom or Hizenga. This argument is not persuasive since process limitations cannot impart patentability to a product that is not patentably distinguished over the prior art.

Applicants also argue that the oxidized starch product obtained by the claimed process is superior to the starch products of both Wikstrom and Huizenga, as illustrated by the examples provided in the application and as further discussed in Applicants response filed August 15, 2003. This argument is not persuasive since the claims as currently written, do not set forth any data that indicates a superior product over the Wikstrom and Huizenga patents.

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In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., viscosity and other properties) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Accordingly, the rejection of Claims 21 and 27-31 under 35 U.S.C. 103(a) as being unpatentable over the Wikstrom WO patent and the Huizenga EP patent is maintained for the reasons of record.

Allowable Subject Matter

13. Claims 15-20 and 32 are allowed.

Reasons for indicating Allowable Subject Matter

14. The following is a statement of reasons for the indication of allowable subject matter: Applicants amended the claimed process for the oxidation of a starch by clearly indicating that the alkaline treatment occurs after the oxidation is complete, wherein the prior art of record set forth the alkaline treatment during the oxidation procedure.

Summary

15. Claims 15-20 and 32 are allowed; Claims 21 and 27-31 are rejected.

Examiner's Telephone Number, Fax Number, and Other Information

16. For 24 hour access to patent application information 7 days per week, or for filing applications, please visit our website at www.uspto.gov and click on the button "Patent Electronic Business Center" for more information.

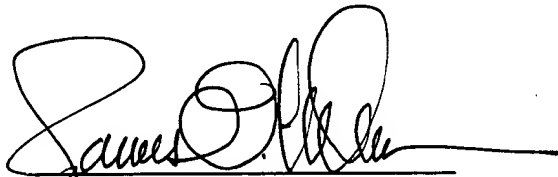
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is (703) 308-4621. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reach on (703) 308-4624. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.


E.White


James O. Wilson
Supervisory Primary Examiner
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